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JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Gregory H. Milby et al.	§	Art Unit:	2164
		§		
Serial No.:	09/733,530	§		
		§	Examiner:	Samuel G. Rimell
Filed:	December 8, 2000	§		
		§		
For:	Managing Allocation of	§	Atty. Dkt. No.:	9362 (NCR.0027US)
	Temporary and Permanent	§		
	Files in a Database System	§		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated March 9, 2006.

(1) REPLY TO EXAMINER'S ANSWER REGARDING DECLARATION UNDER 37 C.F.R. § 1.131

The Examiner continues to object to the Declaration Under 37 C.F.R. § 1.131 as being ineffective in overcoming Zheng.

The Examiner asserts that the lack of signature or dates on the invention disclosure record (Exhibit A to the Declaration Under 37 C.F.R. § 1.131) renders the information contained in the NCR invention disclosure record unreliable and inaccurate.

37 C.F.R. and the M.P.E.P. do not require that documents relating to conception must be signed and dated. The M.P.E.P. states that each exhibit relied upon "should be specifically

Date of Deposit: <u>May 9, 2006</u>
I hereby certify under 37 CFR 1.13(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.
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referred to in the affidavit or declaration, in terms of what it is relied upon to show.” M.P.E.P. § 715.07 (8th ed., Rev. 2), at 700-249. The M.P.E.P. lists several possible examples of exhibits that may be submitted, including sketches, blueprints, photographs, reproductions of notebook entries, and so forth. There is absolutely no indication whatsoever that these exhibits must be signed and dated. It is respectfully submitted that Appellant has satisfied the requirement in the M.P.E.P. that each exhibit relied upon should be specifically referred to in the affidavit or declaration. In the Declaration of Gregory H. Milby, Steven C. Grolemond, and Susan E. Choo 37 C.F.R. § 1.131, reference was specifically made to Exhibit A, which contains the NCR invention disclosure record that was submitted by the inventors to NCR Corporation, the assignee of the present application, regarding the invention *described in the present application*. Thus, in their Declaration, the inventors have specifically referred to the NCR invention disclosure record, attached as Exhibit A, as being the copy of the invention disclosure that was submitted by the inventors to NCR Corporation. This sworn testimony by the inventors is sufficient to authenticate the content of Exhibit A, the NCR invention disclosure record.

The Examiner makes the following statement:

When inventors do not sign or date documents and simultaneously confirm that they are providing true copies of their work, the lack of signatures and dates raise clear doubts about the reliability and accuracy of the information presented, and the examiner is well within his authority to raise these doubts as the basis for ruling that this information renders the affidavit ineffective.

Examiner’s Answer at 8.

Appellant is confused why the sworn testimony provided by the inventors in the Declaration Under 37 C.F.R. § 1.131 would be a basis to raise clear doubts about the reliability and accuracy of the information presented in the invention disclosure record. The inventors, not

the Examiner, are in the best position to determine whether a particular document accurately describes their invention at the time of conception.

Furthermore, in the Declaration of Dan C. Hu, the undersigned declared that the disclosure attached as Exhibit A was the invention disclosure received by the undersigned on or around August 23, 2000. An e-mail attached as an exhibit to the Declaration of Dan C. Hu establishes that such a document was in fact sent from NCR Corporation to the undersigned on or around August 23, 2000. The August 23, 2000 date on which Appellant's outside attorney received the invention disclosure record from NCR Corporation pre-dates Zheng, whose filing date is September 26, 2000. The actual receipt of the invention disclosure record by NCR's outside counsel before the effective date of the prior art reference Zheng provides undisputable evidence that the content of the NCR invention disclosure record pre-dates the effective date of Zheng.

Therefore, the Examiner's objection to the accuracy and reliability of the information contained in the NCR invention disclosure record is unfounded.

For the very first time, the Examiner in the Examiner's Answer alleges that the Rule 131 Declaration does not provide sufficient explanation of Exhibit A (the NCR invention disclosure record). This objection was never raised in the final office action dated March 30, 2004.

The entire content of Exhibit A (the NCR invention disclosure record) provided the basis for the present patent application. The diagram provided in the invention disclosure record is substantially identical to Fig. 2 of the present application. The content of the entire invention disclosure record was described in the present patent application. Thus, the entire content of the invention disclosure record (Exhibit A) provides the explanation of why the invention disclosure record supports the claims of the present application. It is unclear what the Examiner wishes to

have Appellant do – does the Examiner wish for Appellant to paraphrase the content of the NCR invention disclosure record, which has already occurred in the Detailed Description section of the present application? It is respectfully submitted that the Examiner's requirement that an explanation of the content of the NCR invention disclosure record should be provided is without merit. The best source of the information regarding the invention disclosure record is the text contained in the invention disclosure record itself, which clearly supports the claims of the present application.

In the Appeal Brief, Appellant made the comment that the M.P.E.P. allows dates of an exhibit to be removed or blocked off. *See* M.P.E.P. § 715.07, at 2700-250. This is a clear indication by the M.P.E.P. that dates on an exhibit are not required for establishing conception. In response to this argument, the Examiner argued that “[w]hile it is true that the M.P.E.P. does allow for an exception for removal of dates from a document, in this case, the evidence does not support a conclusion that any such information was actually removed.” Examiner's Answer at 9 (emphasis in original). The Examiner appears to have missed the point here – Appellant is not saying that dates have been removed from the invention disclosure record; rather, Appellant's argument is that the section of the M.P.E.P. allowing removal of dates indicates that actual dates are not required in the exhibits to allow an Examiner to make a determination of whether an exhibit establishes conception prior to the effective date of a prior art reference.

With respect to diligence, the Examiner argued as follows:

Since the date of conception is not affirmatively established or confirmed by the inventors, the time lag from conception to contact with Mr. Hu cannot be determined with certainty. The date of conception of March 26, 2000 (shown on the NCR invention disclosure record cover sheet) cannot be confirmed as the date of conception since it was not verified by the inventor's signatures.

Examiner's Answer at 9-10.

Appellant is not relying upon the March 26, 2000 date, because this reliance is absolutely not required. As specifically provided for by the M.P.E.P., the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice. M.P.E.P. § 715.07(a), at 700-252. The effective date of Zheng is September 26, 2000. Thus, the period during which diligence is considered is between a time just prior to September 26, 2000 and the filing date of the present application, December 8, 2000. The date March 26, 2000 is completely *irrelevant*.

Appellant has already established that outside counsel for NCR received a copy of Exhibit A, the NCR invention disclosure record, on or around August 23, 2000, which is clearly before the September 26, 2000 date of Zheng. Appellant does not have to explain the time period between March 26, 2000 and August 23, 2000 – inactivity during that period is not relevant to the determination of diligence with respect to Zheng.

The Examiner further argued that paragraphs 6-8 of the Declaration of Dan C. Hu cannot be confirmed since only e-mails and fax cover sheets were provided, not the actual drafts being relied upon. Examiner's Answer at 10. It is unusual for attorneys or inventors to keep copies of drafts. In any event, copies of such drafts to establish diligence are not required. The e-mails and fax cover sheets are concrete evidence of activity between the undersigned and the inventors on the dates indicated on the Declaration of Dan C. Hu. Such evidence of the activities between the inventors and the undersigned is sufficient to establish diligence. The e-mail and fax cover sheets clearly indicate that drafts were being exchanged for the subject application between the inventors and the undersigned. That is clearly reliable evidence of diligent activity leading to constructive reduction of practice.

Therefore, in view of the foregoing, the Declaration Under 37 C.F.R. § 1.131 is effective in removing Zheng as a prior art reference against the present application.

(2) REPLY TO EXAMINER'S ANSWER REGARDING APPLICATION OF ZHENG

Claim 23

The Examiner objects to Appellant's arguments regarding claim 23 as being "a blanket assertion of patentability without any specific supporting rationale." Examiner's Answer at 11. On page 7 of the Appeal Brief, Appellant noted that the disqualification of Zheng as prior art has overcome the final rejection of claim 23. A detailed rationale was provided regarding why Zheng is disqualified as prior art. Therefore, Appellant has clearly provided rationale regarding why claim 23 is patentable over Zheng.

Claims 1-13, 15-21, 27, and 28

With respect to claim 1, the Examiner continues to contend that the table of Fig. 3 in Zheng is a form of persistent storage device. Examiner's Answer at 11. This assertion that a table is a form of a storage device is clearly based on an unreasonable construction of the term "storage device" recited in the claims. A table is stored in a storage device – a table itself is not a form of storage device. In fact, a table is a data structure formed of bits of data, and thus cannot be considered a storage device. A person of ordinary skill in the art looking at the claims will understand that a "storage device" as recited in the claim requires some type of a physical device for storing data; in the context of claim 1, a first file management context or a second file management context.

Moreover, claim 1 further recites a "persistent data storage device," which is a more specific type of storage device. A persistent data storage device is a storage device that maintains its content even if power is lost to the storage device.

The Examiner argues that the first three columns of the block index shown in Fig. 3 of Zheng constitute the first file management context recited in claim 1, and all the columns of the block index of Fig. 3 of Zheng constitute the second file management context. Note that the block index 39 shown in Fig. 3 is part of an in-memory file system index 37. Zheng, 6:32-33, 45-50. Because everything shown in Fig. 3 is stored in memory, the structure of Fig. 3 fails to satisfy the recitation in claim 1 that a *persistent data storage device stores the first file management context, and a non-persistent memory stores a second file management context*. Thus, even though Zheng refers to a specific device for storing the block index 39 depicted in Fig. 3, the Examiner chooses to ignore the specific device, and instead, relies upon a data structure, in the form of a table, to equate to the persistent storage device recited in the claim.

The Examiner also challenges Appellant's argument that the in-memory content is destroyed upon power loss, stating that Appellant has failed to cite to any passage in Zheng to support this contention. A person of ordinary skill in the art looking to the teachings of Zheng would clearly understand the difference between non-persistent memory and a persistent storage device. Fig. 1 of Zheng shows a disk 22, which is an example of a persistent storage device. In column 5, lines 55-67 of Zheng, reference is made to recovery after a system crash, where a file structure on the disk 22 is used to restore the file system. The disk 22 in Zheng is distinguished from the term "memory," also used in Zheng. A person of ordinary skill in the art would clearly understand that an in-memory structure is not intended to be maintained across a power loss. Thus, the Examiner's position that the content of a memory is not lost after a power loss runs against the well known understanding of persons of ordinary skill in the art, and is clearly inconsistent with the actual use of words of Zheng itself, which distinguishes between a disk (persistent storage) and memory (non-persistent storage).

Claims 14, 22, 26, and 29

With respect to claim 14, the Examiner states that “the claim recites conflicting features which cannot occur simultaneously.” Examiner’s Answer at 12. This is an inaccurate characterization of claim 14. Claim 14 specifies two conditions. Claim 14 recites that an access module performs at least one of a transaction locking and database logging operation *when updating the first file management context* (“condition 1”), and the access module does not perform the transaction locking and database logging operations *when updating the second file management context, but not updating the first file management context* (“condition 2”). Thus, claim 14 recites the access module performing a first task under condition 1, and a second task under condition 2. To satisfy claim 14, Zheng must teach an access module that is able to perform the first task under condition 1 and the second task under condition 2.

Zheng clearly fails to satisfy the elements of claim 14. The Examiner appears to have ignored the access module performing the second task under condition 2 in rejecting claim 14 over Zheng. That is clearly an unreasonable construction of claim 14. All words of the claim must be considered when rejecting the claim over the prior art. Zheng clearly does not satisfy the elements of claim 14.

For the foregoing reasons, as well as the reasons set forth in the Appeal Brief, reversal of the final rejections and allowance of all pending claims is respectfully requested.

Respectfully submitted,

Date: _____

May 9, 2006



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